PATENT
Attorney Docket No. 01165.0940-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Group Art Unit: 2833
Akiyoshi Murakami	)	Examiner: Miska, Vit W
Application No.: 10/528,145	)	Confirmation No.: 6376
Filed: October 25, 2005	)	
For: ELECTRONIC CLOCK	)	

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Commissioner for Patents
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the Final Office Action mailed May 27, 2009, the period for response to which extends through August 27, 2009. This Request is being filed concurrently with a Notice of Appeal.

Applicant has met each of the requirements for a pre-appeal brief review of the rejections set forth in the Final Office Action mailed May 27, 2009 ("FOA"). The application has been at least twice rejected. Applicant has filed a Notice of Appeal with this Request, and has not yet filed an Appeal Brief. Lastly, Applicant submits a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. *See* Official Gazette Notice, July 12, 2005. Therefore, Applicant requests review of the Examiner's rejections in the FOA for at least the following reasons.

REMARKS

Claims 1-20 remain pending in this application. In the FOA, the Examiner maintained the rejections of claims 1-5, 11-14, and 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,396,772 to Yabe et al. ("*Yabe*") and of claims 1, 2, 12, 13, and 20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,785,435 to Inoue et al. ("*Inoue*"). The Examiner withdrew the rejection of claims 1-4, 11-13, and 20 under 35 U.S.C. § 102(b) as being

anticipated by Japanese application 63-21891 to Rhythm Watch Co. Applicant respectfully traverses the rejections under § 102 over *Yabe* and *Inoue*.

Rejection of Claims 1-5, 11-14, and 20 under 35 U.S.C. § 102(e) as being anticipated by Yabe:

As Applicant previously explained, *Yabe* does not disclose each and every element of the claims 1-5, 11-14, and 20. For example, *Yabe* does not disclose at least a "power source input detecting circuit for detecting an input of a newly inserted second power source during a halted state of the timepiece," as recited in independent claim 1. Applicant respectfully notes that in a § 102 rejection, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236 (Fed. Cir. 1989). *See also* M.P.E.P. § 2131.

The Office asserts that the voltage detecting circuit 92 of *Yabe* corresponds to the claimed "power source input detecting circuit" (FOA at 2). In response to Applicant's remarks that voltage detecting circuit 92 of *Yabe* simply detects a charging voltage VC of a large-capacity secondary power supply 48, not "an input of a newly inserted second power source" (emphasis added), nor "during a halted state of the timepiece," the Office contends that voltage detecting circuit 92 of *Yabe* "detect the input of the second power source at all times" (FOA at 6.) This is not correct.

As a preliminary matter, the Office provides no support for its allegation that *Yabe* "detect[s] the input of the second power source at all times" (FOA at 6), even upon "an input of a newly inserted second power source" and "during a halted state of the timepiece" as required by claim 1. Indeed, *Yabe* provide no support for such an allegation. *Yabe* merely teaches that "voltage detecting circuit 92" is "for detecting a charging voltage VC of the large-capacity secondary power supply 48 and an output voltage of the step-up/down circuit 49." (*Yabe* at col. 14, ll. 14-16.) *Yabe* fails to teach or suggest that such detection includes detecting a voltage of secondary power supply 48 when it is "newly inserted." *Yabe* also fails to teach or suggest that such detection occurs "during a halted

state of the timepiece." In fact, *Yabe* is silent with respect to a "newly [insertion]" of the secondary power supply 48.

Even assuming that the Examiner alternatively relies on an "inherency" argument to support the allegation that *Yabe* "detect[s] the input of the second power source at all times," including at a time of "an input of a newly inserted second power source" and "during a halted state of the timepiece," such an argument would be without merit. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112(IV), internal citations omitted (emphasis added). Thus,

> [t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.* (emphasis added)

In this case, the Examiner has not provided extrinsic evidence to establish that the missing claim elements are necessarily present in *Yabe* to satisfy all the elements of independent claim 1. Therefore, the current record does not support an inherency argument. Because each and every element of claim 1 is not found "either expressly or inherently described" in *Yabe* (*see Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987)), claim 1 is allowable. Claims 2-5, 11-14, and 20 depend from claim 1 and are thus allowable at least by virtue of their dependence. Applicant therefore requests the withdrawal of this rejection.

Applicant notes that *Yabe* also fails to teach or suggest "a control circuit for controlling the switch circuit to connect the first power source and the second power source so that the first power source is charged by the second power source, thereby operating the clock circuit, when the power source input detecting circuit detects an input of the second power source," as recited in claim 1 (emphasis added). As explained above, *Yabe* is silent with respect to a "newly inserted" secondary power supply. Therefore, control circuit 93 of *Yabe* cannot

control a switch circuit when a power source input detecting circuit detects an input of a second power source which is "newly inserted," as required by claim 1.

Rejection of Claims 1, 2, 12, 13, and 20 under 35 U.S.C. § 102(b) as being anticipated by Inoue:

Inoue does not disclose each and every element of claims 1, 2, 12, 13, and 20. For example, *Inoue* does not disclose at least a "power source input detecting circuit for detecting an input of a newly inserted second power source during a halted state," as recited in claim 1. The Office asserts that the voltage detecting means 4 of *Inoue* corresponds to the claimed "power source input detecting circuit," and that the condenser C1 of *Inoue* corresponds to the claimed "second power source." (FOA at 4.) The Office also asserts that voltage detecting means 4 of *Inoue* detects "an input of a newly inserted" condenser C1 of *Inoue* "during a halted state." (*Id.*) These statements are incorrect.

As discussed above in connection with *Yabe*, the Office does not provide any support for its allegation that *Inoue* "detect[s] the input of the second power source at all times" (FOA at 6), even upon "an input of a newly inserted second power source" and "during a halted state of the timepiece," as required by claim 1. Indeed, *Inoue* provides no support for such an allegation. Instead, voltage detecting means 4 of *Inoue* detects the voltage of a plurality of condensers, not "an input of a newly inserted second power source." In fact, *Inoue* neither teaches nor suggests that any of the condensers are "newly inserted" into a timepiece, let alone detecting "an input of a newly inserted second power source during a halted state."

Since the Office has not provided extrinsic evidence to establish that the missing claim elements are necessarily present in *Inoue* to satisfy all the elements of independent claim 1, the current record does not support an inherency argument. Because each and every element of claim 1 is not found either expressly or inherently described in *Inoue*, claim 1 is allowable. Claims 2, 12, 13, and 20 depend from claim 1 and are thus allowable at least by virtue of their dependence. Applicant therefore requests the withdrawal of this rejection.

Applicant notes that *Inoue* also fails to teach or suggest "a control circuit for controlling the switch circuit to connect the first power source and the second power source so that the first power source is charged by the second power source, thereby operating the clock circuit, when the power source input detecting circuit detects an input of the second power source," as recited in claim 1 (emphasis added). As explained above, *Inoue* is silent with respect to a "newly inserted" secondary power supply. Therefore, charge control means 6, which the Office contends to be the claimed "control circuit," cannot control a switch circuit when a power source input detecting circuit detects an input of a second power source which is "newly inserted," as required by claim 1.

Conclusion

In view of the foregoing, Applicant respectfully requests that the rejections be withdrawn and the claims allowed.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully Submitted

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Dated: August 27, 2009

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